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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,461	07/24/2003	Wendy Eason	60027.0351US01/BS02512	1318
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EXAMINER				
BROWN, CHRISTOPHER J				
ART UNIT		PAPER NUMBER		
2439				
MAIL DATE		DELIVERY MODE		
11/03/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/626,461

Applicant(s)

EASON, WENDY

Examiner

CHRISTOPHER J. BROWN

Art Unit

2439

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant argues that the combination of Meffert and Nagai fails to teach whether a user may choose to protect an email message. The Applicant argues that Nagai does not teach this feature, however, the examiner does not rely on Nagai to choose to protect an email. The examiner relies on Meffert to teach choosing to send an email in a protected mode. If the user in Meffert does not select the protected mode, the email is sent out as normal by hitting the send button [0083], Fig 2A.

Applicant argues that it would be inappropriate to combine Meffert and Nagai, but both are in the art of email, and both are in the art of security, so they are of analogous arts. The examiner is merely replacing the encryption of Meffert with the image conversion of Nagai.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The rejection below is substantially similar to the previous rejection. New claims 21, and 22 are intended use. The rejection meets the claim limitations because a user may choose to send the first email protected and choose to send the second email without write protection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 6-15, 17, 18, 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meffert US 2003/0037261 in view of Nagai EP 1016972 A1

As per claims 1, and 11 Meffert teaches message composition logic to composer a message to at least one recipient (email text composer) [0083]. Meffert teaches logic protection to protect the message against subsequent alteration by the at least one recipient upon receiving a user indication to enable the write protect logic (specialized button to encrypt and sign to create a package) [0083]. Meffert teaches conversion of a format of a text a body of the message to a format protected against alterations (encrypted package remains encrypted on recipients machine, signed to prevent alteration, DRM digital shredding, blocked from editing) [0083], [0093]-[0095].

Meffert fails to teach converting the text into a picture format.

Nagai teaches composing and email message and converting the message from text to an image [0034]. Nagai teaches the conversion takes place at the client prior to being sent to a recipient [0034]. It would have been obvious to one of ordinary skill in the art to use the graphical conversion of Nagai with the security of Meffert because it allows viewing without specific fonts.

As per claim 4, Meffert teaches the email is stored on a central server [0077].

As per claims 6, and 14, Nagai teaches the image is a JPEG image [0034].

As per claims 7, and 13, Nagai teaches the image is a GIF image [0034].

As per claims 8, and 12, Nagai teaches conversion of the body text of a message to an image [0034]. The examiner takes official notice that a PDF file is a well known image file.

As per claim 9, Meffert teaches the logic allows the user to compose a new message [0083].

As per claim 10, Meffert teaches the logic allows a plurality of options including enabling write protect (specialized button) [0083].

As per claim 15, Meffert teaches the logic enables the user to choose whether to protect the message or not (specialized button) [0083]

As per claim 17, Meffert teaches the message is stored on a central server [0077].

As per claim 18, Meffert teaches the message can be downloaded for viewing [0098].

As per claims 21, and 22, Meffert teaches a selection button so that the user may choose to send a plain text email, or a protected email [0083]. Thus a first email may be protected, and a second email may be regular text.

Nagai teaches conversion of the text of a message to an image [0034].

Claims 3, 5, 19, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meffert US 2003/0037261 in view of Nagai EP 1016972 A1 in view of Ogilvie US 6,711,608

As per claims 3, 19, Ogilvie teaches that an email may have images included as an inline image (Col 6 lines 20-26).

As per claims 5, and 20, Ogilvie teaches that an email may have images attached to the main body (Col 6 lines 20-26).

It would have been obvious to one of ordinary skill in the art to use the attachment options of Ogilvie with the previous email system to expand options for the user.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Throop US 2003/0145057 teaches an email system where the text is converted to an image. Nguyen US 7,251,677, Col 3 lines 60-65, Claim 1, teaches converting text to graphics to send in a message.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER J. BROWN whose telephone number is (571)272-3833. The examiner can normally be reached on 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edan Orgad can be reached on (571)272-7884. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher J Brown/
Primary Examiner, Art Unit 2439

10/30/09